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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/041,698    03/13/98    HUFFER    S    47852

IM62/0928

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EXAMINER

LU RUTT, C

ART UNIT

PAPER NUMBER

1713

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DATE MAILED:

09/28/99

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trad marks**

# Office Action Summary

Application No.  
09/041,698

Applicant(s)  
Huffer et al.

Examiner  
Caixia Lu-Rutt

Group Art Unit  
1713



☐ Responsive to communication(s) filed on \_\_\_\_\_.

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-14 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1-14 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☒ None of the CERTIFIED copies of the priority documents have been  
☒ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 2&3

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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### DETAILED ACTION

#### *Claim Rejections - 35 USC § 112*

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 3-12 and 14 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The "organic oxide as a carrier" in Claim 3 is not disclosed in the Specification.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 8 and 9 recite the limitation "an organic oxide as a carrier" in claim 3. There is no antecedent basis for this limitation in the claim.

#### *Claim Rejections - 35 USC § 102/103*

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1, 2 and 12-14 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Shinosaki et al. (JP 07-025946, translated copy), Noristi et al. (US 5,244,854), Ebara et al. (EP 0 657 477 A2) or Yanagihara et al. (EP 0 712 869 A1) independently.

The instant claims are directed to a propylene homopolymer with high isotacticity which has a specified solubility behavior in xylene and a film, fiber or molding thereof.

Shinosaki et al. teach a propylene homopolymer with extremely high isotacticity pentad value and a film, filaments or molding thereof (page 6, the last paragraph; and pages 45-46).

Noristi et al. teach a propylene homopolymer with high isotacticity (Table 1B).

Ebara et al. (page 4, lines 10-18, page 12, lines 11-21, and Table 1) and Yanagihara et al. (page 3, lines 14-19, page 12, lines 17, and Table 2-1) teach homopolypropylene with high isotacticity and films or sheets thereof.

Although Shinosaki et al., Noristi et al., Ebara et al. or Yanagihara et al. have not disclose the types of solubilities of the polypropylene in xylene as the instant claims, a skilled artisan would

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have expect<sup>ed</sup> that the polypropylene of Shinosaki et al., Noristi et al., Ebara et al. or Yanagihara et al. would have had the same or similar solubility behavior in xylene because the solubility behaviors are controlled by the isotacticities of the polypropylene and considering similarity between the process of Shinosaki et al., Noristi et al., Ebara et al. or Yanagihara et al. and that of the instant application.

Once a product appearing to be substantially identical is found and a 35 USC 102/103 rejection made, the burden shifts to the applicant to show an unobvious difference. In re Fessmann, 180 USPQ 324.

Claims 12-14 are product by process claims. "Even though product-by process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product do not depend on its method of production. If the product-by- process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." In re Thorpe, 227 USPQ 964.

### *Claim Rejections - 35 USC § 103*

8. Claims 3-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shinosaki et al. (JP 07-025946, translated copy) <sup>and</sup> ~~or~~ Noristi et al. (US 5,244,854) independently.

The instant claims are directed to a process for preparation of polypropylene homopolymer by a catalyst system comprising a) a titanium-containing solid component obtained by reacting a titanium halide with a chlorine-free magnesium compound, an inorganic oxide carrier, an alkanol and an electron donor; and as cocatalyst b) an aluminum compound and c) a further electron donor.


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Shinosaki et al. teach a generic catalyst system which encompasses the instant claim (page 17, formula (iii); page 18, [0054] and [0056]; page 19, [0057] and [0059]; page 21, lines 3-7 and 20-23; page 22, (3); page 23, (4) and (5); page 27, lines 16-17; and page 29, [0098] and [0099]).

Noristi et al. teach a propylene homopolymer with high isotacticity prepared by a generic catalyst system which encompasses the instant claim (Table 1B; col.3, line 59; col. 4, line 48; col. 5, lines 6-17 and line 44; and col. 6, lines 29-54)..

Thus, it would have been obvious to a skilled artisan at the time the invention was made to prepare an isotactic propylene homopolymer with a catalyst system comprising a) a titanium-containing solid component obtained by reacting a titanium halide with a chlorine-free magnesium compound, an inorganic oxide carrier, an alkanol and an electron donor; and as cocatalyst b) an aluminum compound and c) a further electron donor since such is within the generic disclosure of Shinosaki et al. or Noristi et al..

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Caixia Lu-Rutt (Ph. D.) whose telephone number is (703) 306-3434. Any Fax communication for this application should be sent to (703) 305-5408.

  
DAVID W. WU  
PRIMARY EXAMINER  
GROUP 1500

CL

September 20, 1999